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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/242,803	02/24/1999	NATHALIE EL KHIATI	3633-462	1528

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EXAMINER

SAMPLE, DAVID R

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 01/27/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicant(s)</b>	EL KHIATI ET AL.	
	<b>Application No.</b>	09/242,803	
	<b>Examiner</b>	<b>Art Unit</b>	
	David Sample	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19,20 and 23-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19,20 and 23-33 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Any rejections and/or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn. The rejection over Kohli et al. (WO 96/11887) is withdrawn because Kohli et al. fails to disclose or suggest a glass having the recited  $\phi$  property, and there is no basis for asserting that the glass of Kohli et al. inherently possesses the property.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Objections***

Claim 26 is objected to because of the following informalities:

Claim 26 does not end in a period.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

Claims 19, 20, and 23-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Siedel et al. (US Patent No. 5,990,023).

It appears that the applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Siedel et al. discloses glasses that have a thermal stress factor of 0.69 and 0.76 N/(mm<sup>2</sup>•K), and transformation points of 1061 and 1190°C. See col. 4, lines 7-12 and col. 5, lines 2-8. The "transformation point" is the temperature where the glass has a viscosity of 10<sup>4</sup> dPa•s. See col. 3, lines 27-28. This definition is identical to the definition of "working temperature" recited in the specification. See page 6, lines 25-26 of the instant specification. Thus, Siedel et al. discloses a glass having a working temperature of less than 1200°C. The reference discloses glasses having a thermal expansion of 7.6x10<sup>-6</sup>K<sup>-1</sup> and 7.9x10<sup>-6</sup> K<sup>-1</sup> at col. 4, lines 7-8 and col. 5, lines 3-4.

As to claim 20, Siedel et al. discloses glasses having softening temperatures of 761 and 800°C. See col. 4, lines 7-12 and col. 5, lines 2-8.

As to the strain points recited in claims 19 and 23, the reference fails to disclose a strain point associated with the disclosed glasses. However, a glass' composition determines its viscosity characteristics upon heating. The glass disclosed by Siedel et al. is identical to the glass described by instant claims 25-28. See col. 4, lines 65-67. Therefore, because the glass of Siedel is identical to the presently claimed glass, the glass of Siedel et al. is assumed to inherently possess the recited strain points. See MPEP 2112.

As to the remainder of claim 23, Siedel et al. discloses a glass having working point of 1061 and 1190°C, and a thermal expansion coefficient of 7.9 x 10<sup>-6</sup> /K. See col. 4, lines 7-12, col. 5, lines 3-9. These properties fall within the ranges recited in instant claim 23. The reference discloses that the glass has a softening point of 750 to 830°C. See col. 5, lines 37-38. This range is sufficiently specific to anticipate the range recited in instant claim 23. See MPEP 2131.03.

As to claim 24, the reference fails to disclose the recited values of  $\phi^2 \cdot c/a$ . However, the value of the recited property for a glass is dependent upon the glass composition, and the how the glass is made. The glass recited by Siedel et al. has a glass composition that is identical to the glass recited in instant claims 19 and 25-28. See col. 4, lines 65-67. Moreover, the glass is made in a manner that is identical to the method applicants' employ in forming their glass. In particular, the glass is melted, formed, and thermally toughened. See col. 3, lines 66 to col. 4 line 27, and col. 5, lines 10-15 of Siedel et al. and page 16, lines 1-12 of the specification. Accordingly, the property of " $\phi^2 \cdot c/a$ " recited in instant claim 24 is assumed to be inherent to the glass of Siedel et al. because the glass of Siedel et al. has the same composition and is made in the same manner. See MPEP 2112.

The glass composition disclosed by Siedel et al. at column 4, lines 65-67 has amounts of components that fall within the ranges of components recited in instant claims 19 and 25-28. As to claim 28, it is noted that the claim recites a lower limit for SrO of 3 wt% whereas the reference discloses 2.5 wt% SrO. However, the SrO content in claim 28 is claimed in one significant figure. The amount of SrO disclosed by Siedel et al. is recited in two significant figures, i.e., 2.5 wt%. See col. 4, line 66. If the SrO of Siedel et al. were recited as one significant figure, it would be 3 wt%. Thus, the reference discloses a glass having 3 wt% SrO. Therefore, the reference is deemed to anticipate instant claim 28.

As to the  $\phi$  recited in instant claim 29, the reference discloses a glass that has a thermal stress factor of 0.76 N/(mm<sup>2</sup> K). See col. 5, lines 4-5.

As to the  $\log \rho_{(250^\circ)}$  recited in claims 29 and 30, the  $\log \rho_{(250^\circ)}$  of a glass is dependent upon its glass composition. The glass of Siedel et al. is identical to the glass recited in instant claims

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25-28. See col. 4, lines 65-67. Accordingly, the property of  $\log \rho_{(250^\circ)}$  recited in instant claims 29 and 30 is assumed to be inherent to the glass of Siedel et al. because the glass composition of Siedel et al. is identical instantly claimed composition. See MPEP 2112.

As to claims 31 and 32, the reference discloses forming a monolithic glazing pane from the disclosed glass compositions. See col. 3, lines 11-12.

As to claim 33, Example 3, col. 4, of the reference contains the recited amount of  $\text{SiO}_2 + \text{Al}_2\text{O}_3 + \text{ZrO}_2$ .

### ***Response to Arguments***

Applicant's arguments filed June 15, 2001 have been fully considered but they are not persuasive.

#### Rejection under § 102(e) over Siedel et al. (US Patent No. 5,990,023)

Applicants assert that Siedel et al. is not prior art because the reference has a filing date that is after the claimed foreign priority date. This argument is not deemed persuasive. In order to be entitled their foreign priority date, the foreign priority documents must support the present claims under 35 U.S.C. § 112, first paragraph. See MPEP 201.15. The foreign priority documents do not adequately support the claims under 35 U.S.C § 112, first paragraph.

In particular, the foreign priority document no. 197 10 289.1 fails to provide adequate written support for at least the following recitations:

- The upper limit of  $88 \times 10^{-7} \text{ }^\circ\text{C}^{-1}$  for thermal expansion coefficient (the '289 application discloses an upper limit of  $85 \times 10^{-7} \text{ }^\circ\text{C}^{-1}$  at page 6, lines 1-7 of the translation);

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- The upper limit of 1200 °C for working temperature (the '289 application discloses an upper limit of 1190°C at page 6, lines 1-7 of the translation);
- The upper limit of 0.85 N/(mm<sup>2</sup> °C) for  $\phi$  (the '289 application discloses an upper limit of 0.8 N/(mm<sup>2</sup> °C) for  $\phi$  at page 6, lines 1-7 of the translation);
- The lower limit of 55 wt% for SiO<sub>2</sub> (the '289 application discloses a lower limit of 65 wt% in claim 4 of the translation);
- The lower limit of zero for Al<sub>2</sub>O<sub>3</sub> (the '289 application discloses a lower limit of 0.5 wt% Al<sub>2</sub>O<sub>3</sub> in claims 3 and 4 of the translation); and
- The upper limit of 7 for Al<sub>2</sub>O<sub>3</sub> (the '289 application discloses an upper limit of 1.5 wt% Al<sub>2</sub>O<sub>3</sub> in claims 3 and 4 of the translation).

The foreign priority document no. 197 07 521.1 fails to provide adequate written support for at least the following recitations:

- The upper limit of  $88 \times 10^{-7} \text{ }^{\circ}\text{C}^{-1}$  for thermal expansion coefficient (the '521 application discloses an upper limit of  $85 \times 10^{-7} \text{ }^{\circ}\text{C}^{-1}$  in claim 6 of the translation);
- The lower limit of 4.5 wt% for Na<sub>2</sub>O (the '521 application discloses a lower limit of 5 wt% for Na<sub>2</sub>O in claim 7 of the translation);
- The lower limit of 7 wt% for CaO (the '521 application discloses a lower limit of 8 wt% for CaO in claim 7 of the translation); and

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- The range for  $B_2O_3$  of 0-3 wt% (the '521 application fails to recognize that  $B_2O_3$  may be included in the glass).

The foreign priority document no. 197 05 364.1 fails to provide adequate written support for at least the following recitations:

- The upper limit of  $0.85 \text{ N}/(\text{mm}^2 \text{ } ^\circ\text{C})$  for  $\phi$  (the '364 application discloses an upper limit of  $0.84 \text{ N}/(\text{mm}^2 \text{ } ^\circ\text{C})$  for  $\phi$  at page 2, lines 31 of the translation).
- The upper limit of 7 wt% for  $Al_2O_3$  (the '364 application discloses an upper limit of 5 wt%  $Al_2O_3$  at page 4, line 15 of the translation);
- The lower limit of 0 wt% for  $ZrO_2$  (the '364 application discloses a lower limit of 3 wt% for  $ZrO_2$  at page 4, line 16 of the translation);
- The upper limit of 10 wt% for  $Na_2O$  (the '364 application discloses an upper limit of 8 wt%  $Na_2O$  at page 4, line 18 of the translation); and
- The upper limit of 12 wt% for  $CaO$  (the '364 application discloses an upper limit of 8 wt% for  $CaO$  at page 4, line 19 of the translation).

The examiner reiterates that he has not exhaustively compared the priority documents and the instant claims to determine which recitations do, and do not, have adequate written support in the priority documents. **If applicants wish to amend their claims in order to be entitled to priority, they should carefully review their priority documents and the claims to be sure the priority documents provides adequate written support for the present claims.**



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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Sample whose telephone number is (703)308-3825. The examiner can normally be reached on Monday to Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703)308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



David Sample  
Primary Examiner  
Art Unit 1755

DRS  
January 22, 2003